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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/605,553	06/27/2000	David Black	E0295/7119 MBL	5747

7590 03/24/2006

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EXAMINER

ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,553

Applicant(s)

BLACK, DAVID

Examiner

Neveen Abel-Jalil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/20/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-15,17-19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-15,17-19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20-Janaury-2006 has been entered.

2. The amendment filed on 20-Janaury-2006 has been received and entered. Claims 3, 16, and 20 have been cancelled. Therefore, claims 1,2,4-15,17-19 and 21-32 are now pending.

Claim Objections

3. Claims 1, 15, 26, 29, 31, and 32 are objected to because of the following informalities:

Claim 1, line 8, recite “can be used” is indirect, suggest optionally, and passive which renders any recitation claimed after not be given patentable weight. It does not actually have to take place. Therefore giving little meaning to receiving an access request without actually performing it.

Claim 15, line 8, recite “using the ELVID to assure” which constitute intended use and does not carry patentable weight since it never has to occur. Claim should be amended to recite more firm and positive language (i.e. “is” or “that” or “wherein”).

Claim 15, line 10, recite “usable to access” which constitute intended use and does not carry patentable weight since accessing never has to occur. Claim should be amended to recite more firm and positive language (i.e. “is” or “that” or “wherein”).

Since there’s more than one intended use, the entire step of assurance hence accessing does not ever have to happen. Appropriate correction is required.

Claim 26, line 8, recite “usable to access” which constitute intended use and does not carry patentable weight since accessing never has to occur. Claim should be amended to recite more firm and positive language (i.e. “is” or “that” or “wherein”).

Claim 29, line 9, recite “usable to access” which constitute intended use and does not carry patentable weight since accessing never has to occur. Claim should be amended to recite more firm and positive language (i.e. “is” or “that” or “wherein”).

Claim 31, line 12, recite “usable to access” which constitute intended use and does not carry patentable weight since accessing never has to occur. Claim should be amended to recite more firm and positive language (i.e. “is” or “that” or “wherein”).

Claim 32, line 8, recite “usable to access” which constitute intended use and does not carry patentable weight since accessing never has to occur. Claim should be amended to recite more firm and positive language (i.e. “is” or “that” or “wherein”).

Claim 32, recite “means for verifying” without having any previous and/or another mention of “means” recitation at all in this claim or the preceding claim of which it depends. The recitation should be deleted or amended to confirm with MPEP. Appropriate correction is required. See *MPEP* 2164.08(a) Single Means Claim stating:

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 15, and 31-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 15, and 31-32 are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application. The use of a computer has not been indicated.

These claims do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. Furthermore, there is no hardware or storage tied to the claimed steps in order to realize their functionality. Claim 1, for example; merely recite the step of “accessing from a host computer” and not performing the method steps using the computer. Moreover, claim 1 makes no indication of the actual “request” being stored in hardware.

Similarly, Independent claims 15, 31, and 32 have no tangible embodiment or hardware tied to the claim limitations in order to realize their functionality. A mere recitation of a computer but never using the computer to process, execute, or store the steps of the claim is not sufficient.

Claims should be amended to recite computer/hardware and tangible output tied to the claimed limitations in order to realize their functionality.

6. Claims 26, 27, and 29-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 5, 9, and 20 are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application (see MPEP 2106 IV.B.2.(b)). The definitions given in the specification for a system is broad enough so as to not include a practical application within the

technological arts, and no tangible result is produced in the claims. The claims should entail transformation of article or material to a different state or thing with final results achieved “useful, tangible, and concrete”. The claims should be amended so that some kind of output is required and/or so a tangible result is produced.

In claim 26, there is no indication of real world result/output to the “being usable to access” step appearing to take place. The actual accessing and displaying or presenting or showing the result is missing.

Claim 27, similarly, does not show real world result or tangible concrete output to the “being usable to access the correct” step. There’s no result to the verifying step.

Claims 29-32, similarly, does not produce real world out or tangible concrete results to the “verifying” step claimed.

7. Claims 27 and 29 preamble recite “storage system for” the limitations following the phrase “*for*” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “*for*” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form.

In claim 27, “an input for receiving”... “ a storage medium to store” and “ELVID verifier” do not have to functionally to be tied to together in a storage system. They do not have to be used in an enterprise and do not have to be used to perform the stated functionality. They do not have to actually take place. A claim must be directed to a series of steps preformed in a

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computer or computer implemented or contains positive recitation such as “is” or “that” or “a storage system in an enterprise”

Similarly claim 29 have the same deficiency. Correction is required.

Allowable Subject Matter

8. Claims 1,2,4-15,17-19 and 21-32 would be allowable if rewritten or amended to overcome the objections and rejection(s) under 35 U.S.C. 101, set forth in this Office action.

Response to Arguments

9. Applicant's arguments with respect to claims 1,2,4-15,17-19 and 21-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sanada et al. (U.S. Patent No. 6,523,096 B2) teaches registration table and password authentication in storage management.

Blumenau et al. (U.S. Patent No. 6,839,747 B1) teaches user interface for storage volume management.

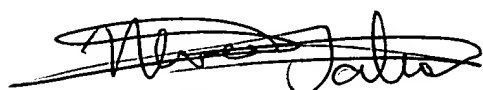
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'N. Abel-Jalil', with a stylized flourish at the end.

Neveen Abel-Jalil
March 16, 2006